



REMARKS

Claims 1 – 35, 40 – 58, 60 – 63, and 66 – 204 are pending. Claims 36 – 39 are canceled herein, while claims 59 and 64 – 65 were previously canceled. An appendix attached hereto is included with the language of all the pending claims without underlining or other delineations to make the task of reviewing the present application easier for the Examiner.

RE-WRITING ALLOWABLE CLAIMS AS NEW CLAIMS

As an initial matter, the Applicants appreciate the prompt action by the Examiner as expressed by the allowance of claims 53 – 58, 60 – 63, 66 – 71, and by the indication that claims 2, 4-5, 7, 12 – 13, 17 – 19, 21, 23, 28, 34 – 45, 41, 43 – 44, 46, 51, 52, 77, 81, 94-96, 98 – 100, 103, 104, 117, 124, 127, 130 and 133 embody allowable subject matter as noted in paragraph 16 of the Office Action.¹ The latter allowable claims have been re-written as new claims 141 – 204 to conform to the Examiner's determination on these allowable aspects of the present application. The correlation to the claims allowed by the Examiner and the new claims is as follows:

<u>Allowed claim</u>	<u>New Claim</u>
2	141 (independent)
4, 5	143, 144
7	146
13	147
12	148 (independent)
17	152 (independent)
18 - 19	155 – 156
21	158 (independent)
23	159 (independent)
28	160 (independent)
35	161 (independent)
34	166 (independent)
41	167 (independent)
43 – 44	169 – 170
46	172
51	178 (independent)
52	177
77	179 (independent)

¹ As noted in the telephone conference, paragraph 16 is slightly inconsistent with paragraph 15. However, the undersigned has reviewed the Office Action and believes that the above formulation is what the Examiner intended as the claims that would be allowable in this instance. For this reason, the list here is slightly different from the list presented in paragraph 15, but it is believed to be accurate. If not, the Examiner is invited to correct the same in a manner that affords the Applicants an opportunity to respond appropriately if necessary.

81	183
94	186
95 – 96	187 – 188
98	189
99 – 100	190 – 191
103	192 (independent)
104	194
117	195 (independent)
124	197 (independent)
127	199 (independent)
130	201 (independent)
133	203 (independent)

The other new claims included herein depend from those claims that the Examiner has already indicated are allowable, so they should be allowable as well. They do not present any new issues or introduce any new subject matter, as can be evidenced by a review of the same.

Please note that while the Examiner indicated that all of the above original claims (in the left hand column) were allowable in independent form, the Applicant, for cost reasons (and no other reason) has elected not to prosecute all of these claims in this fashion. Nonetheless, the Applicant acknowledges and appreciates the confirmation of the independent and separate patentability of all the aforementioned claims on the public record as noted by the Examiner in the Office Action.

RESPONSE TO REJECTIONS OF OTHER PENDING CLAIMS - § 112

In addition, the undersigned appreciates the opportunity granted by the Examiner to discuss the merits of the present case during a telephone conference on April 11, 2001. As an initial matter, Applicant notes that the § 112 rejection of the subject matter embodied in claims 3, 38, 42, 63, 74 and 78 was discussed, and that some understanding was reached that the specification does in fact clearly provide open ended - and not limiting – examples of the ranges of values providable for the filter status fields. As described in the specification at page 8, while an example of a scale of 1 – 10 is provided, it is also explained that any number of coding bits can be provided for such field, and it is expected in fact that such would vary according to the particular implementation. Thus, Applicants believe that this rejection has been adequately addressed at this stage.

RESPONSE TO REJECTIONS OF OTHER PENDING CLAIMS - § 103

As also set out in these discussions on April 11, Applicant believes that a reasonable and careful reading of the claim language indicates that they already differentiate quite clearly over the

cited references, including the Bradshaw reference currently relied upon by the Examiner. In particular, Applicants explained how the Bradshaw reference does not quite operate in the manner that the Examiner may have thought at first glance. Nonetheless, to make these distinctions more apparent, some language changes have been made, not for patentability reasons or concerns, but to better clarify the scope of various aspects of the present inventions that are already clearly patentable within the requirements of the statutes.

For instance, it was explained during the telephone conference that while the Bradshaw reference does discuss filtering of documents created by the users of such system (by intercepting keyboard entries), and filtering of documents accessed by such users, the approach and structure shown is rather static and inflexible. In particular, from an initial document distribution perspective, it applies a single fixed filtering rule to *every* document that is created (i.e., not a document by document basis), and certainly does not consider adjusting a filter based on *who the intended recipients* are for a particular document (i.e., not on a recipient by recipient basis). Since the entire system is predicated on a single supervisor imposing a uniform rule that is intended to apply to all materials and all users (i.e., such as to protect minors from accessing inappropriate online materials) Bradshaw in fact teaches away from the kind of flexibility embodied in the present claims. Thus, it and the other prior art clearly does not meet or make obvious the language of claim 1 and the other claims rejected in light of such references.

Nonetheless, to makes such distinctions more clear, Applicants have amended claim 1 to clarify the kind of documents that are being reviewed (i.e., documents that have not yet been distributed to an intended recipient) and read that the filter words are adjustable on a recipient by recipient basis and/or on a document by document basis. This level of control is discussed at length in the specification (see e.g., page 10, ll. 4 – 21; page 11, ll. 4 – 9; page 12, ll. 8 – 25, among other places) and characterizes one of the useful features of this aspect of the present invention. There is clearly no such functionality expressed or suggested in Bradshaw, because it would run contrary to the type of approach being used there. A cursory review will reveal that it does not describe or suggest that a language filter be selected either on a document by document basis, or on a recipient by recipient basis, or that initial distribution of a document be performed in such manner. Accordingly, claim 1 is believed to clearly embody patentable subject matter at this time for reasons beyond those already acknowledged by the Examiner for the other claims indicated to be allowable.

The other pending independent claims pertaining to this aspect of the invention, including claims 40, 72, 76, 93, 97, 101, 115, 118, 123, 126, 129, 132, 135 and 138 have been similarly

amended, so they are also believed to be in allowable form at this time. Where appropriate, any dependent claims have also been amended to conform to the new language presented in their independent counterparts.

Claim 14 was previously amended to indicate that the designation of a word as offensive and/or potentially inappropriate is modifiable by the author of an electronic document. Again, Applicants submit that the Examiner has perhaps misunderstood how the Bradshaw reference deals with initial creation of documents by users of such system. In particular, Bradshaw imposes very rigid rules on a document drafter (as evidenced by the keyboard capturing mechanism and lockout scheme) and they cannot be circumvented or altered by an author. To do so, in fact, would defeat the whole purpose of Bradshaw's filtering mechanism. In contrast to Bradshaw, this aspect of the present invention focusses on user ease of use features, and permits a document author to custom tailor how documents are checked.

Thus, the Bradshaw technique teaches away from the present approach, and this strongly evidences the non-obviousness of the present approach in independent claim 14. For this reason, Applicants submit that this claim should be in allowable form at this time.

Remaining independent claims 24 and 29 have been amended in similar form so as to conform to the same kind of inventive concepts embodied in claim 14: i.e., the aspect of author control over document creations using customized filtering mechanisms. Again, where appropriate, any dependent claims have also been amended to conform to the new language presented in their independent counterparts.

CONCLUSION

The claims indicated as allowable have been re-written as new claims in accordance with the Examiner's instructions.

All but one (claim 14) of the remaining pending independent claims have been amended as noted above to better clarify the scope of the present inventions. Only one of the independent claims (14) was not amended, as it is believed to already present and clearly express significant non-obvious subject matter.

A check in the amount of \$ 1256 has been enclosed to cover the cost of the additional filing fees for the additional claims (17 independent claims, 64 total new claims).



Should the Examiner believe it that it would be helpful to discuss any of the above points in person, Applicant is open to a telephone conference (415-551-8298) at any convenient time.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Nicholas Gross".

Date: April 13, 2001

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I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to the Commissioner of Patents and Trademarks, this 13th day of April 2001